

REMARKS

Reconsideration of this application is respectfully requested.

This application has been reviewed in light of the Office Action dated April 5, 2006. Claims 1-5, 8-14 and 17-19 are currently pending in the application. Claims 15 and 16 were canceled previously. Claims 6 and 7 are canceled with this amendment. Claims 1 and 14 have been amended. Claim 19 has been added. Support for these amendments is provided at least in paragraphs 0047, 0049, 0077-0086 and 0091-0095. The elements of Claim 6 have been added to Claim 1 and the elements of Claims 1 and 7 have been combined into new claim 19. Adequate support for Claim 19 is disclosed in at least paragraphs 0047, 0049 and 0077-0086. Therefore, it is respectfully submitted no new matter has been added with the addition of Claim 19. Furthermore, the addition of claim 19 after a final rejection is permitted because of the cancellation of claims 6 and 7.

Claims 1-14 and 17-18 were rejected under 35 USC 103(a) as being unpatentable over Lee (US 7,016,851) in view of the USPTO's "Trademark/Service Mark Application, Principal Register, with Declaration", 08/22/00, pp.11 (hereinafter "TEAS").

In regards to Claim 1, the Examiner asserted "Lee teaches a process for registering a trademark by means of a local computer (Fig. 2:221) connected to a remote computer (Fig. 2:231, 234, 241, 253, etc) via a computer Internet network (column 7, lines 40-41 and 61-62) performing the following steps in order: entering the trademark ...; sending the validated entry and selection...; and retransmitted the validated entry and selection..". The Examiner goes on to state: "Lee does not specifically teach selecting the products or services to which the trademark applies from at least one of an official class and validating the entry and selection". The Examiner then asserted "TEAS teaches selecting the products or services to which the trademark applies from at least one of an

official class (Page 4: “International Class” and “Listing of Goods and/or Services”) and validating the entry and selection (Page 8: “Validate Form”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2:221) transmitting the trademark filing documents (Column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23)."

In regards to Claims 6 and 7, the Examiner admits “Lee does not specifically teach” the limitations of Claims 6 and 7. However, the Examiner asserted “TEAS teaches displaying both one number of an official class of products or services with its heading and vice versa (Page 4: “International Class” and “001-0042, A, B or 200”; Page 11: e.g., “028” and “Table Tennis balls”).

Lee is directed to an intellectual property filing portal which facilitates selection, by applicants (or representatives), of particular jurisdictions and associates based at least in part on fee quotations in accordance with particulars of an intellectual property filing and in accordance with fee structures of the particular jurisdictions and foreign associates. In addition, the intellectual property filing portal facilitates registration of associate- and jurisdiction-specific form documents and fee schedules for at least partially automated preparation of formal documents. Illustrations are provided in the context of a patent application filing. Although Lee discloses that “the present invention may be configured to support other intellectual property filings (e.g., to secure trademarks or copyrights)”, no description for filing a trademark registration application is provided (see col. 12, lines 25-31 of US 7,016,851).

TEAS is directed to electronic filing of trademark applications provided by the United States Patent and Trademark Office (USPTO). Pages 1-9 of the TEAS reference cited by the Examiner shows a Trademark/Service Mark Application located at teas.uspto.gov/V1.22/TMS1FORM.htm on the USPTO website. Pages 10 and 11 of the cited TEAS reference appears to be a search engine for the Trademark Acceptable Identification of Goods and Services Manual located at www.uspto.gov/web/offices/tac/doc/gsanu..., located on a different portion of the USPTO's website.

Claim 1 of the instant application is directed to a process "for preparing a trademark registration application to filed at a national administrative department responsible for examining the application" including the steps of, inter alia, "(i) entering the trademark to be filed at the national administrative department, (ii) selecting at least one displayed heading of at least one official class of the products or services to which the trademark applies and displaying a corresponding number of the at least one official class in the trademark registration application, (iii) validating the entry and the selection, (iv) sending the validated entry and selection to the remote computer via the computer network, the remote computer being disposed on a premises of an intellectual property attorney for reviewing the trademark registration application, (v) retransmitting the validated entry and selection from the premises of the intellectual property attorney to another remote computer to enable the application to be prosecuted at the national administrative department, said steps being carried out in the order indicated" (emphasis added). The process of Claim 1 facilitates the preparation of a trademark application by allowing an applicant to select products or services from known official classes of products and services. By "selecting at least one displayed heading of at least one official class", the

process of Claim 1 will enable the applicant to select products or services that should be accepted by the national administrative departments, e.g., corresponding trademark offices, responsible for examining the trademark applications with a view to nationally or internationally registering the trademark in the application. The process of Claim 1 will then “display[ing] a corresponding number of the at least one official class in the trademark registration application” thus completing two of the more difficult entries of the trademark registration application (see instant application paragraph [0008]). The applicant of the trademark application will then send the validated entry of the trademark and selection of goods and services and corresponding official class number to a remote computer of an intellectual property attorney for review, who will then transmit the application to the national administrative department. By having the applicant select at least one heading of an official class and causing the corresponding class number to be displayed, the process of Claim 1 will reduce some of the difficulties associated with preparing a trademark registration application.

Neither Lee nor TEAS disclose “selecting at least one displayed heading of at least one official class of the products or services to which the trademark applies and displaying a corresponding number of the at least one official class in the trademark registration application,” as recited in Claim 1. Lee does not provide any detail on how to file a trademark registration application. The Examiner asserted “TEAS teaches displaying both one number of an official class of products or services with its heading and vice versa (Page 4: “International Class” and “001-042, A, B, or 200”; “Page 11, e.g., “028” and “Table Tennis balls”). However, neither page 4 nor 11 of the TEAS reference cited by the Examiner shows or suggests displaying the heading of the official class. On page 4 of the TEAS reference, a user can enter an International Class number but that entry will not

result in the heading of the official class being displayed. There is no where on page 4 that allows the selecting of a heading of an official class and subsequently displaying the corresponding class number. Furthermore, page 11 of the TEAS reference shows a result set after entering a proposed good or service. The result set includes acceptable goods along with the corresponding International Class number. It appears the Examiner has mischaracterized these acceptable goods (e.g., Table tennis balls, Table tennis bats, etc.) as a class heading. In fact, the official class heading for International Class 28 (used in the Examiner's example) is "Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees" (Trademark Manual of Examining Procedure Section 1401.02(a)). Even further, pages 1-9 and pages 10-11 appear to be from different sections of the USPTO's website. There is no indication in the reference or explained by the Examiner on how one would go from the application of pages 1-9 to the Trademark Acceptable Identification of Goods and Services Manual of pages 10-11.

Therefore, it is respectfully submitted that Claim 1, along with dependent claims 2-5, 8-13 and 17, is patentably distinct and not rendered obvious over Lee in view of the TEAS reference.

Similarly, Claim 19 is directed to a process "for preparing a trademark registration application to filed at a national administrative department responsible for examining the application" including the steps of, inter alia, "(ii) selecting at least one displayed number of at least one official class of products or services to which the trademark applies and displaying a corresponding heading of the at least one official class in the trademark registration application". On page 4 of the TEAS reference, a user can enter an International Class number, not select a displayed number of at least one official

class, but that entry will not result in the heading of the official class being displayed. There is no where on page 4 that allows the selecting of a number of at least one official class and subsequently displaying the corresponding heading of the official class. Furthermore, page 11 of the TEAS reference shows a result set after entering a proposed good or service. The result set includes acceptable goods along with the corresponding International Class number. Neither the class number nor suggested goods are selectable which would enter them into the trademark registration application. Even further, pages 1-9 and pages 10-11 appear to be from different sections of the USPTO's website. There is no indication in the reference or explained by the Examiner on how one would go from the application of pages 1-9 to the Trademark Acceptable Identification of Goods and Services Manual of pages 10-11. Therefore, it is respectfully submitted that new Claim 19 is patentably distinct and not rendered obvious over Lee in view of the TEAS reference.

In regard to Claim 14, the Examiner asserted "Lee does not teach comparing said freely chosen wording with potential wordings contained in a file of at least one official class of products and services; selecting at least one wording from among the wordings proposed; displaying the number of the official class corresponding to the wordings selected; and validating the entry and the selection". The Examiner then asserted TEAS teaches these features on page 10 and 11 of the TEAS reference (see page 9 and 10 of the Office Action dated April 5, 2006).


Claim 14 is directed to a process "for preparing a trademark registration application to filed at a national administrative department responsible for examining the application" including the steps of, inter alia, "(ii) entering in the application at least one freely chosen wording for describing the products or services to which the trademark applies, (iii) comparing said freely chosen wording with potential wordings contained in a

file of at least one official class of products and services, (iv) displaying proposed wordings from among the potential wordings, (v) selecting at least one wording from among the displayed proposed wordings and entering the selected wordings in the trademark registration application, (vi) displaying a number of the official class corresponding to the wordings selected in the trademark registration application, (vii) validating the entry and the selection". The process of Claim 14 facilitates preparation of a trademark registration application by providing the applicant with proposed wordings for goods and services associated to the trademark. The process further facilitates preparing the trademark registration application by displaying wordings to a user and then entering the wordings in the application selected by the applicant via the local computer, i.e., the entry and selection steps are all completed while the applicant is in the application. Page 10 and 11 of the TEAS reference illustrates a separate web page of the USPTO's website and is not part of the trademark application form shown on page 4 of the TEAS reference. Although the Examiner does not explain how he combines the two sections, in practice, a user would go to the Trademark Acceptable Identification of Goods and Service Manual web page, shown in the reference at page 10, and enter a good or service. A listing of acceptable goods or services would result as shown on page 11 of the TEAS reference. The user would then choose an acceptable good or service from the list and then either write it down, memorize it or cut and paste the choice into the trademark application form shown on page 4 of the TEAS reference, that is, the user can not select a choice and have it automatically transferred to the form or select a choice right in the form. Neither Lee nor the TEAS reference disclose or suggest "entering in the application at least one freely chosen wording" and "selecting at least one wording from among the displayed proposed wordings and entering the selected wordings in the trademark registration application" as

recited by Claim 14. Furthermore, neither Lee or the TEAS reference suggest or disclose "displaying a number of the official class corresponding to the wordings selected in the trademark registration application". Therefore, it is respectfully submitted that Claim 14, along with dependent claim 17, is patentably distinct and not rendered obvious over Lee in view of the TEAS reference.

In view of the preceding amendments and remarks, it is respectfully submitted that all pending claims, namely claims 1-5, 8-14 and 17-19 are in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicants' attorney at the number given below.

Respectfully submitted,



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